

### **REMARKS**

Applicants acknowledge receipt of the Office Action dated December 23, 2003. In that Action, the Examiner, in response to the filing of an Appeal Brief, withdrew a previously Final Office Action and: 1) objected to claim 20 for a lack of antecedent basis; 2) rejected claims 16, 18, 20, and 23 under 35 U.S.C. § 102(b) as being anticipated by *Blake* (U.S. Patent 3,770,232); 3) rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over *Blake* in view of *Shah et al.* (U.S. Patent 6,137,747); 4) rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over *Blake* in view of *Phelps, Jr. et al.* (U.S. Patent 4,062,422); and 5) allowed claims 1-15, 17, 19, and 25-26.

#### **Objected Claims**

Claim 20 has been amended to depend from claim 19 and now has proper antecedent basis. Because claim 20 now depends from an allowed claim, claim 20 should also be allowed.

#### **Rejections under 35 U.S.C. § 102(b)**

Claims 16, 18, 20, and 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,770,232, issued to Blake (hereinafter *Blake*). In order for a reference to anticipate the scope of a claim under 35 U.S.C. 102(b), the reference must teach every aspect of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. MPEP 706.02. Further, an anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990).

*Blake* is directed to a shock and vibration isolation mount for marine gas turbines. *Blake* Title, and Col. 2, Lines 1-10. The mount includes a flange 40 supported by a sleeve 36 that translatably surrounds a body constructed from hollow rods 14 and 50 connected by shank 62. *Blake*, Col. 2, Line 58 to Col. 3, Line 13. A plurality of "Belleville" springs 34, 56 are positioned on either end of the sleeve 36 in order to dampen shock loads transmitted into flange 40. *Blake*, Col. 1, Lines 59-66 and Col. 3, Lines 20-25. Belleville springs are disc-shaped metal springs that have a variable incremental

deflection so that shock loads are increasingly attenuated with a high degree of damping to provide soft bottoming. *Blake*, Col. 4, Lines 2-6. "Shell casings 66 and 68 are provided to cover the stacked metal springs 56 and 34 respectively." *Blake*, Col. 3, Line 37-39.

With respect to independent claim 16 and claims 18 and 23, which depend from claim 16, *Blake* does not anticipate "a plurality of springs connected in series to form an elongated body . . ." The body of the mount of *Blake* is formed from hollow rods 14 and 50 connected by shank 62. Because the body of *Blake* is not formed by the plurality of Belleville springs, *Blake* does not anticipate the scope of claim 16. Claim 16 also claims ". . . a plurality of housings corresponding in number to and disposed about said springs . . ." *Blake* includes one shell casing 66 or 68 for each set of stacked metal springs 34 or 56. *Blake* does not include a number of housings corresponding in number to the number of springs as is required, and therefore can not anticipate the scope of claim 16. Claim 16 also claims "wherein said housing limits the axial deflection of said springs." The specification of *Blake* makes no mention of a mechanical limit to the deflection of the springs, but seems to rely on the variable incremental deflection of the metal springs to assure soft bottoming. *Blake*, Col. 4, Lines 2-6. If *Blake* included a housing that would limit the deflection of the springs, the housing would prevent the soft bottoming performance of the stacked metal springs. Therefore, since *Blake* does not teach a housing that limits the axial deflection and would not operate as taught with a housing that limits the axial deflection, *Blake* does not anticipate the scope of claim 16. Thus, for at least the reasons detailed above, it is clear that the teachings of *Blake* do not anticipate the scope of claims 16, 18, or 23.

#### **Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over *Blake* in view of U.S. Patent 6,137,747, issued to Shah et al. (hereinafter *Shah*) and rejected claim 24 as being unpatentable over *Blake* in view of U.S. Patent 4,062,422, issued to Phelps, Jr. et al. (hereinafter *Phelps*). When patentability is questioned as being obvious, the prior art references must suggest or teach the motivation to combine the references. *In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). As stated in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The mere fact that the prior art may be modified in the manner

suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner rejected claim 21 as being unpatentable over *Blake* in view *Shah*. *Shah* teaches an acoustic transmitter having certain components coated with Teflon to preserve free axial movement. *Shah*, Col. 5, Lines 51-55. Teflon coating is a hard surface coating intended to reduce friction between contacting surfaces. Teflon is neither a resilient material nor an attenuating material.

The Examiner relies on *Blake* to teach all of the elements of claim 21 except for the springs being coated with a layer of resilient material. The Examiner relies on *Shah* to teach springs coated with a layer of resilient material. *Shah* teaches coating springs with a friction reducing material and does not teach or disclose any components coated with a resilient material. Therefore, the reliance on *Shah* to teach a resilient or attenuating coating is improper. For this reason, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of obviousness with respect to claim 21. Further, the Examiner's rejection of claim 21 depends on *Blake* teaching all of the elements of claim 16, from which claim 21 depends. As discussed above, *Blake* does not teach all of the elements of claim 16. Therefore, the Examiner's rejection of claim 21 based on the combination of *Shah* and *Blake* should be withdrawn.

The Examiner rejected claim 24 as being unpatentable over *Blake* in view *Phelps*. *Phelps* teaches an external covering for steel sonar domes comprising a layer of dampening material covered by an antifouling rubber sheet. The covering protects the sonar dome from a seawater environment and helps to isolate the sonar equipment from flow and hull vibrations while allowing the transmission of sonar signals. *Phelps* Col. 1, Lines 36-55.

With respect to claim 24, the Examiner relies on *Phelps* to teach coating the outer housings with an attenuating material. The Examiner offers no indication of the motivation found in either *Phelps* or *Blake* as to why someone would combine the shock absorber of *Blake* with the sonar dome covering of *Phelps* to create the claimed acoustic attenuator. Without some objective evidence as to why it would someone would be motivated to combine the shock absorber of *Blake* with the sonar dome covering of *Phelps*, the Examiner's rejection does not meet the requirements for a *prima facie* case of obviousness. Further, the Examiner's rejection of claim 24 depends on *Blake* teaching all of the elements of claim 16, from which claim 24 depends. As discussed above, *Blake* does not teach all of



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the elements of claim 16. Therefore, the Examiner's rejection of claim 24 based on the combination of *Phelps* and *Blake* should be withdrawn.

### Conclusions

During the course of these remarks, Applicant has at times referred to particular limitations of the claims which are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. They are as required by law. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction.

If the Examiner has any questions or comments regarding this communication, he is invited to contact the undersigned to expedite the resolution of this application.

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